

Remarks

As stated above, Applicants appreciate the Examiner's thorough examination of the subject application and request reexamination and reconsideration of the subject application in view of the preceding amendments and the following remarks.

As of the office action of Sep. 30, 2009, claims 1-2 and 21-36 were pending in the subject application, of which claims 1 and 28 are independent claims. With this response Applicants have amended claims 1, 28, and 29. Claim 29 was amended to correct a typographical error. Amended claims 1 and 28 were amended to recite, in part:

a steering committee tool that displays a graph of merger performance by month, a graph of performance indicators by performance area, and a list of merger issues categorized by department and division.

Applicants contend that no new matter has been added with this amendment because the subject matter is contained in the original application as filed. (See e.g. Subject Application at ¶ 88, FIG. 11). Applicants also amended claim 1 by inserting the term "by a restructuring integration process running on a system[.]" Applicants contend that no new matter has been added with this amendment because the subject matter is also contained in the original application as filed. (See e.g. Subject Application at ¶¶ 41-43, FIGs 1-2).

A. Summary of the Office Action

- (i) The Examiner rejected claims 1, 2, and 21-27 under 35 U.S.C. § 101. (Office Action at p. 2)
- (ii) The Examiner rejected claims 1, 2, 21, 23, 24-27, 28-30, and 32-36 under 35 U.S.C. § 103 over U.S. Patent No. 6,671,692 ("Marpe") in view of U.S. Patent No. 5,829,003 ("Okura"). (Office Action at p. 3).

- (iii) The Examiner rejected claims 22 and 31 under 35 U.S.C. § 103 over Marpe, in view of Okura, in further view of U.S. Patent No. 7,159,178 ("Vogt"). (Office Action at p. 10.)

B. Rejections Under 35 U.S.C. § 101

The Examiner rejected claims 1, 2, and 21-27 under 35 U.S.C. § 101. (Office Action at p. 2). The Examiner stated that "providing a first and second interface on a computer display . . . fail[s] to recite a particular machine or apparatus being used to perform the method steps." (Id. at p. 3). Applicants respectfully suggest the Examiner has mischaracterized the requirements of the machine-or-transformation test. The machine-or-transformation test requires a method claim transform underlying subject matter, or to be *tied* to a particular machine or apparatus. (In re Bilski, 545 F.3d 943 (Fed. Cir. 2008)). However, the Examiner suggests that, under the machine-or-transformation test, a claim must state a particular machine used to *perform* the method. Bilski does not appear to include any such requirement. A claim may be tied to a particular machine or apparatus without reciting a particular machine that *performs the method*. Applicants contend that claim 1 was tied to a particular machine or apparatus because, even though the Examiner suggests it did not recite a particular machine that was *performing each element*, it recited a particular machine upon which the elements were performed. For example, claim 1 recites "providing . . . in a graphical user interface on a computer display." The claim is tied to particular machine because it provides a graphical user interface *on a computer display*. There does not appear to be any requirement that the claim recite which machine actually *performs* the step.

However, for the purpose of further prosecution, Applicants have amended claim 1 to recite, in part, "providing, by a restructuring integration process running on a system[.]"

Applicants contend that this amendment further ties the claims to a particular machine. Support for the amendment may be found throughout the specification and drawings. (See e.g. Subject Application at ¶¶ 41-43, FIGs 1-2). Accordingly, Applicants request withdrawal of the § 101 rejection of claim 1, and of claims 2 and 21-27 because they are dependent upon claims 1.

C. Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 21, 23, 24-27, 28-30, and 32-36 under 35 U.S.C. § 103 over U.S. Patent No. 6,671,692 ("Marpe") in view of U.S. Patent No. 5,829,003 ("Okura"). (Office Action at p. 3). In response, Applicants have amended the independent claims. Claim 1 and 28 now recite, in part:

a steering committee tool that displays a graph of merger performance by month, a graph of performance indicators by performance area, and a list of merger issues categorized by department and division.

Applicants contend that, with this amendment, claims 1 and 28 are patentable under § 103 over Marpe and Okura.

Marpe generally discloses an merger and acquisition engine for using chevrons to navigate through a merger process. (See generally Marpe). Marpe, does not, however, appear to disclose or suggest a steering committee tool, as claimed. Although Marpe discloses a chart showing a number of issues (Marpe at FIG. 10), Marpe does not appear to disclose a chart of merger performance by month, a chart of performance indicators by performance area, or a list of merger issues categorized by department and division, as claimed. Okura does not appear to disclose the limitations, either. Okura is generally directed toward a system for processing organizational charts. (Okura at abstract). However, Okura does not appear to disclose "a steering committee tool that displays a graph of merger performance by month, a graph of performance indicators by performance area, and a list of merger issues categorized by

department and division," as claimed. Therefore, Applicants contend that Marpe and Okura, alone or in combination, do not disclose or suggest each and every element of the independent claims. Accordingly, Applicants request withdrawal of the § 103 rejection of claims 1, 2, 21, 23, 24-27, 28-30, and 32-36

The Examiner also rejected claims 22 and 31 under 35 U.S.C. § 103 over Marpe, in view of Okura, in further view of U.S. Patent No. 7,159,178 ("Vogt"). (Office Action at p. 10). As discussed above, Marpe and Okura do not appear to disclose each and every element of the independent claims. Vogt does not remedy Marpe and Okura's deficiency. Vogt is generally directed toward a browser-based software system for connecting people across organizational barriers, and for organizing virtual meetings. (Vogt at abstract). Vogt does not, however, appear to disclose "a steering committee tool that displays a graph of merger performance by month, a graph of performance indicators by performance area, and a list of merger issues categorized by department and division." Therefore, Applicants contend that claims 22 and 31 are patentable under § 103 over Marpe, Okura, and Vogt because they are dependent upon claims 1 and 28 and include all their limitations. Accordingly, Applicants request withdrawal of the § 103 rejection of claims 22 and 31.

D. Conclusion

In consideration of the amendments and foregoing discussion, the application is now believed to be in condition for allowance. Early allowance of the subject application is respectfully solicited. The Examiner is invited to contact Applicants' agent at 617-305-2136 to facilitate prosecution.

This response is not believed to necessitate any additional fees. However, in the event that additional fees are due, please charge or credit any refund to our Deposit Account No. 50-2324.

Respectfully Submitted,

Dated: 30 November 2009

/Seth A. Milman/
Seth A. Milman
Reg. No. 64,573

Holland & Knight LLP
10 St. James Avenue
Boston, MA 02116-3889
Telephone 617-305-2136
Facsimile 617-523-6850